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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,678	01/16/2004	B. Raghav Reddy	HES 2003-IP-011937U1	8611

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EXAMINER	
MARCANTONI, PAUL D	
ART UNIT	**PAPER NUMBER**
1755	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/759,678	REDDY ET AL.	
	Examiner	Art Unit	
	Paul Marcantoni	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39 and 87-113* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39 and 87-113* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's arguments filed 2/16/05 have been fully considered but they are not persuasive.

"Withdrawn" or NON-Elected Claims:

Once again, applicants are respectfully requested to cancel all "withdrawn" (non-elected claims 40-86 and 114-122) in the next response. These claims are *not* re-joinable in accordance with MPEP guidelines and by not canceling it increases the time of compact prosecution.

35 USC 112 Second Paragraph:

Claims 1-39 and 87-113 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The term "high alkalinity" (reference to cement) is a term that the applicants maintain is a term well known in the art and the rejection over this is withdrawn.

The term "high" density particles in claim 7 was held to be indefinite but is now withdrawn. The applicants have now defined it on page 20 of their specification that "high density particles" means particles that are heavier than the settable fluid to which the particles are to be added.

The term "desired" remains indefinite in claims 1, 28, 105, 107 and any other claim it is used. It is equivalent to and synonymous with "predetermined" so it is vague and indefinite. Deletion of this term is again advised.

Removal of the colon in claim 37 and 109 is advised.

The colon in line 1 of claim 1 should be deleted.

The colon in line 2 of claim 17 should be deleted.

The colon in the second line of claim 30 should be deleted.

Claims 1 and 87 are indefinite. The composition cannot be a fluid without water or some other liquid in the composition and should be in this claim.

Delete the colon in claim 93, second line.

35 USC 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-39 and 87-113 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Laramay et al. '318, Abelleira et al. '147 B1, Yamashita et al. '418, Cowan '711 or '654 or '070,* Vijayendran et al. '832 B1, Nadolsky et al. '603, Smith et al. '939, Booth '407, Lu et

al. (CN 1385388), JP 2000191350 (Tobori et al.), JP 09020536 (Tamura et al.), Mizunuma et al. (JP 06128001), Koizumi (JP 05043293), Yamaguchi et al. (JP 61256956), JP 59109663 (Takenaka Komuten Co), or Borchardt (DE 3213799).

The above cited italicized and originally cited references all teach surfactants and/or dispersants (a surfactant is a dispersant) which does adjust the particle size by breaking up an agglomeration of particles and meets the limitation of a "particle size distribution agent" The applicants "particle size distribution" is really a coagulant or flocculent versus a dispersant or surfactant which lowers the surface tension between particles yet both certainly adjust particle size of agglomerated particles (either in one direction or the other) . Should applicants wish for these italicized references that were originally cited to be removed, they should consider inserting at the very least the term ---cationic polymer--- into all independent claims. If they persist in leaving this term in the independent claims, the rejection over the originally cited references will remain and me made final over these references.

The newly added references all teach cementing using a cationic polymer and cement (or gypsum) thus anticipating the instant invention. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

Response

The applicants state that the cationic compounds of the prior art including cationic surfactants are not "particle size distribution adjusting agents". The examiner

disagrees and notes that all references teach that these are surfactants or dispersants that are added which are particle size distribution adjusting agents. The applicants then argue that the prior art does not teach "cationic polymers". Yet, the applicants improperly argue a limitation not in any of their independent claims. Cationic polymer is not, for example, in claim 1. While it is true that the claims may be read in light of the specification, it is improper to read the limitations of the specification into the claims. In re Yamato, 222 USPQ 93; In re Wilson, 149 USPQ 523; Graver Tank v. Linde Air Products Co. 80 USPQ 451 (Supreme Court). Applicants cannot read "cationic polymer" into the independent claims because it is improper and if they argue it it must actually be present in that claim. Applicants may consider insertion of this term into all independent claims at the very least to overcome the original art cited in the rejection (but not the new art which actually does teach adding cationic polymers to cement and allows for setting).

Obviousness Type Double Patenting:

Claims 1-39 and 87-113 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,796,378 B2 (Reddy et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a composition and method comprising mixing a cationic polymer (cationic derivatized starch), calcium aluminate (cement), water, and the use of a retarder (col.2, line 46).

Reddy et al. do not teach placing at a desired location yet one of ordinary skill in the art would have understood cementing can be done at their own place of choosing.

The applicants did submit a terminal disclaimer and the rejection has not been been removed yet but held in *abeyance* pending PTO personnel evaluating whether it is proper. It is expected that they will find it proper and the rejection will be removed as soon as it is determined but at this time the terminal disclaimer has not been acted upon yet by PTO personnel and no communication has yet been submitted by those people to the examiner indicating it is proper and thus it cannot be removed until this is done. It is expected there will be a decision (at least it is hoped) by the applicant's next response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Marcantoni
Primary Examiner
Art Unit 1755